

## REMARKS

The above amendments and these remarks are responsive to the Office action mailed December 20, 2005. Claims 1-38 are pending in the application. Claims 1-6, 8-9, 13-15, 25-29, 31-34, and 37-38 were rejected under 35 U.S.C. § 102(b) as being anticipated by Miura et al. (U.S. Patent No. 5,989,658). Claims 16-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hastey (U.S. Patent No. 6,494,763). Claims 7 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. in view of Dahl (U.S. Patent No. 3,284,947). Claims 10-12, 30 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. in view of Piotrovsky (U.S. Patent No. 4,470,784).

In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### Rejections under 35 USC § 102

Claims 1-6, 8-9, 13-15, 25-29, 31-34, and 37-38 were rejected under 35 U.S.C. § 102(b) as being anticipated by Miura et al. (U.S. Patent No. 5,989,658). In order to anticipate a claim, a reference must disclose each and every element recited in the claim. *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

With respect to independent claim 1, applicant traverses this rejection as Miura et al. fails to disclose, teach, or suggest a high-volume insert for an injection-molded toy figure having a body portion configured to occupy at least 50% of a volume of an associated portion of an appendage, as recited in claim 1. Without acknowledging the propriety of the rejection, and in the interest of furthering the prosecution of the application, the applicant has amended claim 1 to more particularly recite the invention. In particular, claim 1 has been amended to recite that the

insert has a hollow body portion. Support for the amendment is found at page 1, lines 7-8; page 5, lines 4-6; page 11, line 19 to page 12, line 4; and Fig. 12.

As described on pages 4-5 of applicant's specification, a high-volume insert has many advantages including a decrease in the amount of exterior soft plastic material used in the corresponding toy limb. This may be desirable because most soft plastics are considered less environmentally sound than the rigid plastics that may be used to form an insert. Using high-volume inserts would therefore decrease the amount of PVC and similar materials used in producing flexible doll toys, and would also reduce the amount of PVC waste at the end of toy life. Replacing higher-density PVC with lower-density rigid plastic also may decrease overall toy weight, thereby reducing shipping costs. Moreover, use of a hollow high-volume insert, produced either as a unitary assembly or as a composite assembly of multiple molded parts, would further reduce production costs and environmental waste by requiring less material (see specification at page 5, lines 4-6).

Miura et al. fails to disclose, teach, or suggest the use of a hollow insert as recited in amended claim 1. In contrast, Miura et al. appears to disclose a joint assembly which is capable of a click motion (col. 2, ll. 11-13). A first material forms a joint portion, a second material encloses the joint, and a third material forms the outer covering (col. 7, ll. 28-53). The materials differ by melting point so as not to weld the joint components in a fixed position. There is no mention of material density or the volume of the insert, let alone the use of a hollow insert. Miura et al. fails to disclose each and every element of claim 1 as amended.

For the above reasons, applicant respectfully requests this rejection of claim 1 be withdrawn. Claims 2-6, 8-9, and 13-15 depend from and further limit claim 1. Claims 2-6, 8-9, and 13-15 should therefore be allowed when claim 1 is allowed.

Independent claim 25 has been amended to recite that the high-volume insert has a hollow body portion. For the reasons discussed above with respect to claim 1, applicant respectfully requests the rejection of claim 25 be withdrawn. Claims 26-29 depend from and further limit claim 25. Claims 26-29 should therefore be allowed when claim 25 is allowed.

Independent claim 31 has been amended to recite that the high-volume insert has a hollow body portion. For the reasons discussed above with respect to claim 1, applicant respectfully requests the rejection of claim 31 be withdrawn. Claims 32-34 and 37-38 depend from and further limit claim 31. Claims 32-34 and 37-38 should therefore be allowed when claim 31 is allowed.

**Rejections under 35 USC § 103**

Claims 16-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasteby (U.S. Patent No. 6,494,763). Applicant traverses this rejection. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings, there must be a reasonable expectation of success, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2142.

Independent claim 16 recites, amongst other structure, a high-volume insert having a first body segment and a second body segment detachably joined with the first body segment to form a substantially hollow body of the insert. As noted by the Examiner, Hasteby does not disclose a hollow insert. As discussed in more detail above, Miura et al. also fails to disclose, teach, or

suggest the use of a hollow insert. Applicant disagrees that a hollow insert would have been an obvious design choice. A hollow insert is advantageous in that it reduces production costs and environmental waste by requiring less material. The subject matter of claim 16 is not disclosed, taught, or suggested by the prior art of record. Further, there is no motivation to combine the cited references, and such a combination merely results in a toy doll having a solid internal joint structure. Accordingly, applicant respectfully requests the rejection of claim 16 be withdrawn. Claims 17-24 depend from and further limit claim 16. Claims 17-24 should therefore be allowed when claim 16 is allowed.

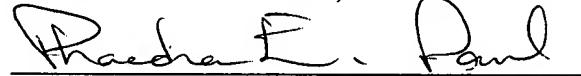
Claims 7 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. in view of Dahl (U.S. Patent No. 3,284,947). Miura et al. fails to disclose, teach, or suggest the use of a hollow insert. This deficiency is not addressed by the combination of Miura et al. with Dahl. The rejection of claims 7 and 35 should therefore be withdrawn. Additionally, claim 7 depends from and further limits claim 1 and should therefore be allowed when claim 1 is allowed. Claim 35 depends from and further limits claim 31 and should therefore be allowed when claim 31 is allowed.

Claims 10-12, 30 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miura et al. in view of Piotrovsky (U.S. Patent No. 4,470,784). Miura et al. fails to disclose, teach, or suggest the use of a hollow insert. This deficiency is not addressed by the combination of Miura et al. with Piotrovsky. The rejection of claims 10-12, 30 and 36 should therefore be withdrawn. Additionally, claims 10-12 depend from and further limit claim 1 and should therefore be allowed when claim 1 is allowed. Claim 30 depends from and further limits claim 25 and should therefore be allowed when claim 25 is allowed. Claim 36 depends from and further limits claim 31 and should therefore be allowed when claim 31 is allowed.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

Respectfully submitted,

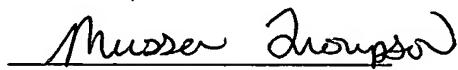
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